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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/692,314 08/05/96 HAMLIN R 910458.CDA

JOHN J. GAGEL
FISH & RICHARDSON, P.C.
225 FRANKLIN STREET
BOSTON MA 02110-2804

IM62/0815

EXAMINER

DYE, R

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/692,314

Applicant(s)

Hamlin

Examiner
Rena L. Dye

Group Art Unit
1772



☒ Responsive to communication(s) filed on Apr 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 206-217 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 206-217 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9/15/99 and 4/21/00

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group II, Claims 206-217 in Paper No. 62 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. The rejections of claims 206-217 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,270,086 has been withdrawn in view of Applicant's filing of a terminal disclaimer (approved).

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4. Claims 206-217 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-34 of copending Application No. 08/907,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims recited in related patent application 08/907,170 are generic to, or encompass, the claims recited in the present patent application. Furthermore, in the present patent application, at page 9, lines 10-11, the specification discloses that balloons produced in accordance with the invention may exhibit a burst pressure well in excess of 7 atm. Therefore, the materials used in making the layers of the presently claimed balloon catheter would inherently possess this burst pressure which is the same as that claimed in the related application 09.907,170.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Information Disclosure Statement

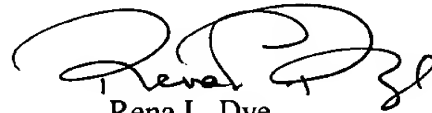
5. The information disclosure statement filed September 15, 1999 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Therefore, the following references have been placed in the application file, but the information referred to therein has not been considered.

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The following non-English references have been struck out on the IDS because a statement of relevance has not been provided: France 998035, France 2328482, German 2848854 A1, Europe 0461474 A1, Europe 0428479 A1, Europe 0292587, Japan 4-34590, and Japan 2-43036.

The second occurrence of Soviet Union 1477423 has been struck out since it is a duplicate citation.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Dye whose telephone number is (703) 308-4331.

A handwritten signature in black ink, appearing to read 'Rena L. Dye', with a stylized flourish at the end.

Rena L. Dye
Primary Examiner
Tech Center 1700

R. Dye
August 11, 2000